

REMARKS

I. The Section 112 Rejection

Claim 1 is pending in the application. The Examiner has objected to the disclosure under 37 C.F.R. §1.65(a), because the photograph in the application is not the proper photograph for the instant variety. Claim 1 stands rejected under 35 U.S.C. § 112, first and second paragraphs, because the claim is drawn to the plant as shown and illustrated but there is no photograph of the claimed variety.

A replacement photograph has been submitted in duplicate with this response. The Examiner's objection has been satisfied and is no longer a basis for rejection under § 112.

The Examiner also believes that an issue of public use or on sale activity has been raised. The Examiner has required Applicant and Assignee (collectively referred to here as "Applicant") to provide additional information that the Examiner has determined is reasonably necessary to properly consider patentability of the claimed invention under 35 USC § 102(b). In particular, the Examiner has required Applicant to explain why a 2002 Garden Mum Catalog was not an offer for sale. The Examiner has also required additional information regarding the offer and sale of the claimed variety that is addressed below.

In 2001, Royal Van Zanten was the exclusive U.S. distributor for the Chrysanthemum varieties of Cleangro Ltd, assignee of the current application. *See* Declaration of Peter Hesse filed June 14, 2004 ("Hesse Decl."), ¶ 3. This included the variety that is the subject of this application with an effective filing date of October 24, 2002. The variety was ready for patenting more than one year prior to the effective date of the instant application.

Also in 2001, Ball Seed Company and its sister company, Ball Superior (collectively "Ball Seed"), became the exclusive sales representative for Royal Van Zanten in the United States and Canada. *See*, Hesse Decl. at ¶ 3. To the Applicant's best knowledge, Ball Seed, as

the exclusive sales representative, generally distributed Chrysanthemum varieties in the U.S. and Canada for Royal Van Zanten, i.e., accepted orders from customers and purchased varieties (as cuttings) from Royal Van Zanten for resale to the customer. It is Applicant's understanding that Ball Seed was also able to order varieties on speculation for resale later in response to subsequent customer orders. Applicant believes that Ball Seed was an independent company operating at arm's length from Royal Van Zanten and was not controlled by Royal Van Zanten or Cleangro. Royal Van Zanten was owned by Royal Van Zanten (Europe), which was also part owner of Cleangro.

The 2002 Royal Van Zanten Garden Mum Catalog was printed on or about October 12, 2001. Hesse Decl. at ¶ 5. Copies of the 2002 Catalog were taken to a conference between Royal Van Zanten and Ball Seed on October 17, 2001, to introduce the varieties shown in the catalog to the Ball Seed sales representatives, including the variety that is the subject of this application. *Id.* The catalog was subsequently mailed out to potential customers of Ball Seed and Royal Van Zanten in the U.S. and Canada. *See* Hesse Decl. at ¶¶ 5, 7-8. Based on the mailing date for the catalog, the catalog would not have been received by the customers prior to October 25, 2001. *Id.* Since the 2002 Catalog was not distributed more than one year prior to the effective U.S. filing date of the instant application, it does not give rise to an on sale issue as to those customers who received it by mail.

Although the catalog was given to Ball Seed more than one year prior to the effective U.S. filing date, the catalog itself was not an offer of sale either at the time it was presented to the Ball Seed sales representatives or subsequently when mailed to potential customers. The catalog was merely an advertisement disclosing the Chrysanthemum varieties of Royal Van Zanten during the 2002 catalog year. *See* Hesse Decl. at ¶ 4. There are no terms of sale given in the catalog, no order forms, no shipping information or cost schedule, and no pricing

information or royalty listing for any variety contained there. Although the catalog admits generally at page two that Royal Van Zanten produces and sells Chrysanthemum cuttings, it makes no reference to the sale or offer of sale of any particular variety in the catalog, including the variety at issue in this application. In addition, to the Applicant's best knowledge, final sale terms such as pricing schedules for the 2002 Catalog were not agreed by Ball Seed and Royal Van Zanten until after the catalog was mailed out to the potential customers and were only available by separate inquiry apart from the catalog. *See Hesse Decl.* at ¶ 6. Moreover, it is Applicant's understanding that Ball Seed would not make or accept any order or offers until at least final pricing terms were agreed.

In and of itself, then, Applicant believes that the catalog did not constitute an offer of sale. *See, Group One, Ltd. v. Hallmark Card, Inc.*, 254 F.3d 1041, 1048 (Fed. Cir. 2001) ("mere advertising and promoting of a product may be nothing more than in invitation for offers"). Pricing information and orders had to be made separately by contacting Ball Seed or Royal Van Zanten directly or through Ball Seed's website. *Hesse Decl.* at ¶ 6. Indeed, the back page of the catalog invited the viewer to "[p]lease contact the Ball salesman in your area for information or orders." The catalog alone lacks all of the characteristic indicia of a UCC offer for sale. *See for example, Linear Technology Corp. v. Micrel*, 275 F.3d 1040, 1050 (Fed. Cir. 2002) ("An offer is the manifestation of willingness to enter into a bargain so made as to justify another person understanding that his assent to that bargain is invited and will conclude it.") quoting *Restatement (Second) of Contracts* § 24 (1981). Moreover, there is no language comprising an offer of sale in the catalog that could have been independently and unilaterally accepted without more by Ball Seed (or any other potential customer) to create a binding UCC contract. *See, GroupOne, Ltd.*, 254 F.3d at 1048 ("[o]nly an offer which rises to the level of a commercial offer for sale, one which the other party could make into a

binding contract by simple acceptance (assuming consideration) constitutes an offer for sale under § 102(b)"). The invitation to "[p]lease contact the Ball Salesman in your area for information or orders" does nothing to cure the lack of commercial sale terms since that contact information makes no offer of sale either. Thus the catalog itself is fatally defective as evidence of on sale activity.

Moreover, to the Applicant's best knowledge, there were no sales or offers of sale of the instant variety prior to the distribution of the 2002 Catalog by mail or, in fact, prior to October 24, 2001. Simply as a practical matter, potential customers would have had no knowledge of the existence of the claimed variety prior to receipt of the catalog by mail, so an offer or sale to such a customer could not have occurred sooner. Applicant has been unable to determine the exact date of the first sale or offer of sale of the instant variety but believes that the earliest it could have occurred would have been through contact with Ball Seed or its website after the catalogs were received in the mail by potential customers and assuming pricing and sale terms were agreed by Ball Seed and Royal Van Zanten. That date could not have been prior to October 25, 2001. The first royalty on sales of the claimed variety was not received by the Assignee until March 2002.

The Examiner has questioned whether sales representatives of Ball Seed were able to place orders for the claimed variety at the time of the conference with Royal Van Zanten on October 17, 2001. Catalogs were distributed to the Ball Seed sales representatives at the conference to introduce the Royal Van Zanten varieties to them (*see* Hesse Decl. at ¶ 5), but as discussed above, the catalogs themselves were not an offer of sale. For such an order by Ball Seed to have occurred, it would have had to happen before pricing was determined since, as noted above, pricing information for the claimed variety as shown in the catalog was not agreed until at least the time the catalogs were mailed out to potential customers. Moreover,

as also noted above, it is Applicant's understanding that Ball Seed would not make or accept any such order until pricing was agreed. Regardless, however, of whether it was theoretically possible for the Ball Seed representatives to place orders as of October 17, 2001, Applicant is not aware of any evidence of such an offer or sale, and to the Applicant's best knowledge, no such sale or offer ever occurred.

The Examiner has also requested further information regarding sales made by Royal Van Zanten directly to a limited number of customers in the U.S. other than through Ball Seed. *See* Hesse Decl. at ¶ 3. To the Applicant's best knowledge, any such sales would only have occurred by direct contact with a select few customers based upon the varieties shown in the 2002 Catalog. As a practical matter, such customers would not have been aware of the variety that is the subject of this application prior to receipt of the catalog by mail, because no other public disclosure of the variety was made prior to the release of the catalog. *See* Hesse Decl. at ¶ 9. Therefore, no such direct sale or offer of sale would have occurred more than one year prior to the U.S. filing date. Indeed, Applicant is not aware of any direct sale or offer of sale of the variety that is the subject of this application more than one year prior to the effective filing date or prior to the mailing of the 2002 catalog, the first royalty payment not occurring until at least March 2002, as noted above.

The Examiner has also inquired whether any orders for the instant variety were received prior to October 24, 2001 and whether any acceptance of any offer was made prior to that date. To the Applicant's best knowledge, no orders were made or accepted prior to that date for the instant variety.

CONCLUSION

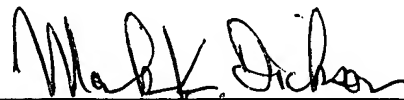
It is respectfully submitted that the Examiner's rejection under 35 U.S.C. § 112 has been overcome by the submission of a replacement photograph and the rejection should now be withdrawn. It is also respectfully submitted that the Applicant has fully responded to the Examiner's Requirement for Information under 35 U.S.C. § 1.105 and that a rejection under 35 U.S.C. § 102(b) does not apply. There are no other rejections or objections to the disclosure or the claim and the application is now believed to be in condition for allowance.

A one-month extension of time to file this response has been requested by separate petition. No additional fees beyond the one-month extension of time are believed to be due, however, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 08-3038 referencing docket number 10451.0054.NPUS01.

The Examiner is invited to contact the undersigned attorney at (650) 463-8234 regarding any further questions, comments or suggestions relating to this patent application.

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Respectfully submitted,



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